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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,253	06/27/2003	Richard D. Morris	21320.004US	4941
22870	7590	10/17/2005		
TECHNOPROP COLTON, L.L.C.			EXAMINER	
P O BOX 567685			HOEL, MATTHEW D	
ATLANTA, GA 311567685				
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 10/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/607,253		MORRIS, RICHARD D.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Matthew D. Hoel		3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>06/27/2003</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figs. 1 and 4 to 11 are informal, being drawn by hand. They were not unclear enough to prevent examination, but are not neat enough to be suitable for publication. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Specification***

2. Claim 14 is objected to because of the following informalities: The claim ends: "... hinge 19." The hinge is referred to as 19 in Fig. 2, but this does not need to be in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

4. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 42 and 46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 42 specifies a person, and

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Claim 46 specifies a human. Then-Assistant Secretary and Commissioner of Patents and Trademarks, Donald J. Quigg, issued a notice in the Official Gazette stating, "A claim directed to or including within its scope a human being will not be considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive, property right in a human being is prohibited by the Constitution." 1077 OG 24 (1987), reprinted in 1146 TMOG 24 (1993).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

7. A person shall be entitled to a patent unless –

8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 to 5, 7, 8, 13, 14, 20 to 22, 25, 26, 29, 35, 39, 40, and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Hussaini, et al. (U.S. design patent D466,130 S).

10. As to Claim 1: '130 has a device for decorating a cable comprising a decorative assembly, and a means for placing the assembly on the cable (Fig. 1).

11. As to Claim 2: The cable of '130 can be part of a video game system.

12. As to Claim 3: The cable of '130 is capable of connecting a game controller to a processing console.

13. As to Claim 4: The cable of '130 has at least one marking (Fig. 1).

14. As to Claim 5: The decorative assembly of '130 has two sections (Figs. 3 and 4).

15. As to Claim 7: It is inherent that the cable of '130 could be included with a video game.

16. As to Claim 8: It is inherent that a plurality of the devices of '130 could be supplied in a single package, especially in light of the fact that most game consoles come with at least two controllers.

17. As to Claims 13, 20, and 39: It is inherent that the cable assembly of '130 can have a unique serial number, especially in light of the fact that most video game consoles (and most other consumer electronics) come with unique serial numbers stamped on them by their manufacturers.

18. As to Claim 14: '130 teaches a decorative assembly with at least one marking (Fig. 1). '130 also has a means for placing the decorative assembly around the cable. '586 teaches two sections each having first and second edges, connected to each other by a hinge on their first edges (Figs. 10 to 12).

19. As to Claim 21: In '130 a decoration is obtained and placed around a cable (Fig. 1).

20. As to Claims 22 and 26: It is inherent that the cable assembly of '130 can have a representation of a company or enterprise name in light of the fact that most consumer electronics devices have their manufacturers' names printed on them.

21. As to Claim 25: At least one decoration is placed on the cable of '130 (Fig. 1).

22. As to Claim 29: The cable of '130 has a chain of more than one decoration (Fig. 1).

23. As to Claims 35, 40, and 45: The decorative assembly of '130 is placed on the cable of a video game system (Fig. 1).

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

25. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 6, 9 to 12, 15 to 19, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hussaini ('130) in view of Hawker (U.S. patent 5,115,586 A).

27. As to Claim 6: Hussaini in '130 discloses all of the elements of Claim 6, but lacks specificity as to the two sections being attached by a hinge, being pivotal about the hinge, and capturing the cable when in the closed position. Hawker, however, in '586 teaches a cable marker for an electrical cable (Abstract). The cable marker has two sections attached by a hinge (Figs. 5 to 8). The sections pivot about the hinge between the open and closed positions and pivot towards each other to capture the cable between them when in the closed position. It would be obvious to one of ordinary skill in the art to apply the cable marker sections of '586 to the cable assembly of '130. The decorative assembly of '130 has two sections (Figs. 3 and 4) and indicia (Fig. 1), and attaches to an electrical cable. The cable marker of '586 likewise has two sections (Figs. 5 to 8) and indicia (Fig. 1), and attaches to an electrical cable. The advantage of this combination would be to have decorative assemblies with indicia that securely

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remain in place and are easily attached to and removed from the controller cables, depending on the player's preferences.

28. As to Claim 9: The cable marker of '586 has two sections that are connected by a hinge that allows the two sections to be pivotally connected to each other, with a portion of the hinge being located on a first side of each of the two sections (Figs. 5 to 8).

29. As to Claim 10: In '586, on the second side of each of two sections is a connecting means that allows the two sections to be reversibly connected to one another (Figs. 10 to 12).

30. As to Claims 11 and 19: The two sections of '586 are mirror images of each other (Figs. 9 and 10).

31. As to Claims 12 and 18: Both of the sections of '586 have internal stabilizing members that abut the cable in the closed configuration (Figs. 11 and 12).

32. As to Claim 15: The hinge of '586 is formed by a region of reduced thickness (Fig. 10).

33. As to Claim 16: In '586, the second edge of one of the sections has two tabs, and the second edge of the other section has two grooves.

34. As to Claim 17: The cable marker of '586 in the closed position has an internal diameter equal to the outside diameter of the cable (Figs. 11 and 12).

35. As to Claim 46: '130 teaches a decorative assembly attached to a video game cable (Fig. 1). '586 teaches a cable marker with first and second half-shell sections that are hinged together along one edge and clip together along the other edge to encircle a

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cable (Figs. 9 to 12). One shell section of '586 has an indicium that is readily perceptible (Fig. 1).

36. Claims 23, 24, 27, 28, 30 to 34, 36 to 38, 41, 42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hussaini ('130) and Hawker ('586) in view of Luciano, et al. (U.S. patent application publication 2002/0077174 A1, application 09/818,306).

37. As to Claim 23: The combination of Hussaini ('130) and Hawker ('586) discloses all of the elements of Claim 23, but lacks specificity as to the decoration representing an accolade for achievement in playing a video game. Luciano, however, in '174 teaches the player receiving an accolade for achievement in playing a video game. The players of '174 are awarded non-monetary prizes as the subjects of bonus awards (Para. 6 and 15). The game pieces have indicia related to a particular theme, which could be a company name, a hobby, or attendance at an event (Para. 46). It would be obvious to one of ordinary skill in the art to apply the game of '174 to the combination of '130 and '586. The game of '174 can be played on home video games, like the game of '130. '174 has non-monetary objects with indicia on them (Para. 6, 15, and 46), like the cable markers of '586. The advantage of this combination would be to stimulate the player's interest in the game by awarding the player an object with indicia representing the theme of the game, which could serve as a souvenir of a trip to the casino or could be cashed in for other non-monetary prizes.



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38. As to Claim 24: In '174, the player can win more than one award credit (Para. 15).

39. As to Claim 27: The playing piece of '174 can have a theme associated with a game (Para. 15).

40. As to Claim 28: Playing video games, like the game of '174, can be a hobby for many people, so an indicium associated with the game could represent a hobby (Para. 15).

41. As to Claim 30: The player of '174 is provided a code at a specific point in the game ("BONUS" awarded during play of primary game, Para. 47), allowed to provide the code to a distributing entity (prize station, Para. 52), and distributed a prize (Para. 52), which can be a device like the combination of '130 and '586.

42. As to Claim 31: In '174, the player is awarded a code upon obtaining the word "BONUS" in the primary game (Para. 47 and 48).

43. As to Claim 32: In '174, the gaming device prints a voucher of credits earned by the player if the player elects to terminate game play (Para. 48).

44. As to Claim 33: In of '174, the player may redeem the credits for prizes online (Para. 24 and 62).

45. As to Claim 34: It is widely known in the art that people pay for items bought from online merchants, such as those of '174, in addition to redeeming gift certificates for merchandise (Para. 62).

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46. As to Claim 36: '174 teaches awarding a prize for performance playing a video game (Para. 47). '130 teaches a decorative assembly associated with a video game (Fig. 1).

47. As to Claim 37: In '174, a player can receive a single token associated with a prize in the form of a single magnetic or smart card (Para. 48). The prize can be a single item, like a car (Para. 52). The game pieces of '174 are decorative assemblies as they have indicia representing a theme on them (Para. 46).

48. As to Claim 38: The game pieces of '174 have indicia representing a particular theme, which could be uniquely associated with a game (Para. 46). The decorative assembly of '130 is associated with a video game.

49. As to Claim 41: In '174, the unique identification numbers of the prizes are verified by a verification server (Para. 54).

50. As to Claim 42: In '174, a player is allowed to compete in a video game (competes against other players in such games as poker, roulette, or blackjack, Para. 43), and awards the player a decorative assembly (a playing piece with indicia, Para. 46).

51. As to Claim 44: In '174, the sponsor of the game is a casino (Para. 16).

52. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hussaini ('130), Hawker ('586), and Luciano ('174) in view of Izumi (U.S. patent application publication 2001/0008852 A1, application 09/750,604).

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53. As to Claim 43: The combination of Hussaini ('130), Hawker ('586), and Luciano ('174) discloses all of the elements of Claim 43, but lacks specificity as to the loser giving the decorative assembly to the winner. Izumi, however, in '852 teaches the loser of a video game giving a game object to the winner (S21, Fig. 4a; S40, Fig. 4b; Para. 47 to 49). It would be obvious to one of ordinary skill in the art to apply the object transfer of '852 to the combination of '130, '586, and '174. This combination would yield a game in which a token would be transferred from a loser to a winner. The game of '852 can be played by multiple players (Fig. 6, Para. 48), like the game of '174 (Para. 43). The game of '852 can be played on personal computers and over a network (Fig. 6, Para. 48), like the game of '174 (Fig. 7, Para. 42 and 65). In both games, players are awarded prizes for achievements made during the game ('174, Para. 16 and 47; '852, Figs. 4a and 4b, Para. 36 to 46). The advantage of this combination would be to stimulate players' interest in the game by not only having a winner and a loser, but also actually transferring something representing victory in the game from one player to another. Such a feature could encourage a friendly rivalry between the players, prompting them to continue playing the game.

54.

***Citation of Pertinent Prior Art***

55. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wu in U.S. patent 5,876,122 A teaches a decorative lamp assembly. Druckman in U.S. patent 5,976,018 A teaches a joystick adapter. Hussaini, et al. in U.S. design patent D480,435 teach a multi-link device for a video game device.

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Hussaini, et al. in U.S. design patent D475,696 teach an audio and video accessory for an electronic device. Hussaini, et al. in U.S. design patent D473,187 teach an RFU adaptor. Hussaini, et al. in U.S. design patent D467,592 teach a video adaptor.

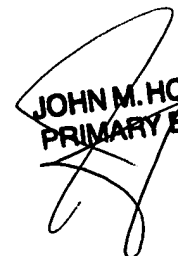
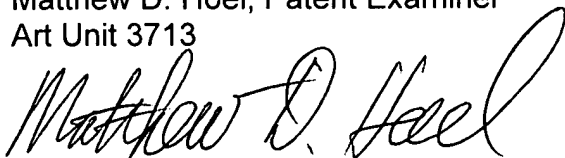
### **Conclusion**

56. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M..

57. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

58. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew D. Hoel, Patent Examiner  
Art Unit 3713



JOHN M. HOTALING, II  
PRIMARY EXAMINER